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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,241	01/21/2004	Kia Silverbrook	WAL20US	2181
24011 7590 09/08/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
NGUYEN, LAM S				
ART UNIT		PAPER NUMBER		
2853				
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09/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/760,241

Applicant(s)

SILVERBROOK ET AL.

Examiner

LAM S. NGUYEN

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,16,18,19,30,36-41 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,16,18,19,30,36-41 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/17/2008 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6944970 in view of Erickson et al. (US 5751303).

- Claim 46 of U.S. Patent No. 6944970 teaches all claimed limitations except determining operation parameters of the printer being selected from the group consisting of remaining media web length, media web tension and end-to-end integrity of the media web, and printing the roll of wallpaper in accordance with the determined operation parameters of the printer.

Erickson et al. teaches a process in a printing apparatus in which printer parameters including remaining web length, web tension and end-to-end integrity of the web are obtained/determined, printer operations for forming images are then processed accordantly to the determined parameters (*column 13, line 65 to column 14, line 11*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify printing apparatus in Claim 46 of U.S. Patent No. 6944970 to perform printing images accordantly to the printer parameters such as remaining web length or web tension as disclosed by Erickson et al. The motivation for doing so would have been to be able to warn a user if inadequate lengths of paper/web are available to complete a print job as taught by Erickson (*column 14, lines 5-11*).

2. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6920704 in view of Erickson et al. (US 5751303).

- Claim 46 of U.S. Patent No. 6920704 teaches all claimed limitations except determining operation parameters of the printer being selected from the group consisting of remaining media web length, media web tension and end-to-end integrity of the media web, and printing the roll of wallpaper in accordance with the determined operation parameters of the printer.

Erickson et al. teaches a process in a printing apparatus in which printer parameters including remaining web length, web tension and end-to-end integrity of the web are obtained/determined, printer operations for forming images are then processed accordantly to the determined parameters (*column 13, line 65 to column 14, line 11*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify printing apparatus in Claim 46 of U.S. Patent No. 6920704 to perform printing images accordantly to the printer parameters such as remaining web length or web tension as disclosed by Erickson et al. The motivation for doing so would have been to be able to warn a user if inadequate lengths of paper/web are available to complete a print job as taught by Erickson (*column 14, lines 5-11*).

3. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7108434 in view of Erickson et al. (US 5751303).

- Claim 1 of U.S. Patent No. 7108434 teaches all claimed limitations except determining operation parameters of the printer being selected from the group consisting of remaining media web length, media web tension and end-to-end integrity of the media web, and printing the roll of wallpaper in accordance with the determined operation parameters of the printer.

Erickson et al. teaches a process in a printing apparatus in which printer parameters including remaining web length, web tension and end-to-end integrity of the web are obtained/determined, printer operations for forming images are then processed accordantly to the determined parameters (*column 13, line 65 to column 14, line 11*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify printing apparatus in Claim 1 of U.S. Patent No. 7108434 to perform printing images accordantly to the printer parameters such as remaining web length or web tension as disclosed by Erickson et al. The motivation for doing so would have been to be able to warn a user if inadequate lengths of paper/web are available to complete a print job as taught by Erickson (*column 14, lines 5-11*).

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over each of claim 48 of copending Application No. 10/760257, claim 47 of copending Application No. 10/760228, claim 47 of copending Application No. 10/760225, claim 49 of copending Application No. 10/760251, claim 48 of copending Application No. 10/760240, claim 48 of copending Application No. 10/760226, claim 48 of copending Application No. 10/760224, claim 49 of copending Application No. 10/760199, claim 48 of copending Application No. 10/760193, claim 49 of copending Application No. 10/760269, claim 49 of copending Application No. 10/760260, claim 49 of copending Application No. 10/760266, claim 49 of copending Application No. 10/760230, claim 41 of copending Application No. 10/760215, or claim 49 of copending Application No. 10/760214 in view of Erickson et al. (US 5751303).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

- Each of the above identified claim in the associated above identified application teaches all claimed limitations except determining operation parameters of the printer being selected from the group consisting of remaining media web length, media web tension and end-to-end

integrity of the media web, and printing the roll of wallpaper in accordance with the determined operation parameters of the printer.

Erickson et al. teaches a process in a printing apparatus in which printer parameters including remaining web length, web tension and end-to-end integrity of the web are obtained/determined, printer operations for forming images are then processed accordantly to the determined parameters (*column 13, line 65 to column 14, line 11*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify printing apparatus disclosed in each identified above application to perform printing images accordantly to the printer parameters such as remaining web length or web tension as disclosed by Erickson et al. The motivation for doing so would have been to be able to warn a user if inadequate lengths of paper/web are available to complete a print job as taught by Erickson (*column 14, lines 5-11*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 6-10, 18-19, 36-37, 40, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Erickson et al. (US 5751303).

Regarding to claims 1, 37, 40:

Martin discloses a method/apparatus for producing wallpaper on-demand, comprising the steps of:

utilizing an on-demand printer comprising a cabinet/frame (*FIG. 2, element 18*) in which is located a media path extending from a media loading area (*FIG. 2, element 24*) to a winding area/dispensing slot adapted to removably retain a core and wind onto it (*FIG. 2, element 26*) and passing a printhead (*FIG. 2, element 20*) located across the media path and on the way to a dispensing slot (*FIG. 2*), there being a processor (*FIG. 2, element 38*) which accepts operator inputs from one or more input devices (*FIG. 2, element 32*) and which controls the printer;

using one or more input devices which communicate with the processor to capture/input/provide data from an operator regarding a selection of a specification, a pattern, and a configuration; running the printer according to the data; printing a single roll of wallpaper, onto a web of blank media, on demand, according to the selected pattern and configuration (*paragraphs [0009]-[0010]*).

- Martin does not teach steps of determining operation parameters of the printer, running the printer for printing images according to the determined operation parameters, wherein the operation parameters selected from the group consisting of remaining web length, web tension and end-to-end integrity of the web.

Erickson et al. teaches a process in a printing apparatus in which printer parameters including remaining web length, web tension and end-to-end integrity of the web are obtained/determined/re-determined, printer operations for forming images are then processed accordantly to the determined parameters (*column 13, line 65 to column 14, line 11*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify Martin's printing apparatus to perform printing images accordantly to the printer parameters such as remaining web length or web tension as disclosed by Erickson et al. The motivation for doing so would have been to be able to warn a user if inadequate lengths of paper/web are available to complete a print job as taught by Erickson (*column 14, lines 5-11*).

- **Martin also teaches the following claimed invention:**

Regarding to claim 6: providing the printer with scanner on a tether for capturing data that specifies a selected pattern or other data (*claims 10-11: Since the printer is a xerographic, the printer comprises a scanner*).

Regarding to claims 8-9: wherein the pattern is selected from printed swatches which correspond to patterns that the printer is able to print on demand, and further comprising the step of: providing a plurality of swatches; assigning a symbol to each swatch; using the symbol as an input to a printer input device (*FIG. 1*).

Regarding to claims 7, 10, 18: the configuration being one or more parameters that customers are allowed to select are selected from the group comprising: roll length, a roll slitting arrangement, one or more modifications to the pattern, or a selection of media to be printed on (*paragraph [0010]*).

Regarding to claim 19: selling printed rolls as they are produced to eliminate printed wallpaper inventory (*FIG. 3*).

Regarding to claim 36: wherein the length and design of the roll are determined by the operator inputs (*paragraph 0010*).

Regarding to claim 48: a motor within the cabinet for advancing the media web out of the media cartridge and one or more motors adapted to urge the media along the path and out of the slot (*FIG. 2: The corresponding motor or motors drive(s) the supply roll, the take-up roll, or the drive roller*).

6. Claims 30 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Erickson et al. (US 5751303), and further in view of Nozawa (US 5701147).

Martin, as modified, discloses the claimed invention as discussed above and also teaches changing the pattern according to a new datum from an operator and then printing a new roll onto the same web (*paragraph [0010]: A user loads a blank roll of wallpaper in the printer and inputs one or more personal images that is/are printed on the blank roll. It means that for each customer or order a blank roll is loaded and printed with a new pattern (design/image). In addition, at certain point of time, when the length of the current roll is not enough for a new order, then a new roll is loaded to the same web for printing images with the new order*). Martin however does not teach wherein the printhead is full width.

Nozawa discloses a printing apparatus comprising full width printheads (*FIG. 9, element 204*) for forming images across a moving printing medium (*FIG. 9, element 203*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Martin's printhead to be full width printhead as disclosed by Nozawa. The motivation for doing so would have been to be able to print the entire width of the printing medium without scanning the printhead to gain printing speed as taught by Nozawa (*column 1, lines 30-39; column 3, lines 57-62*).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Erickson et al. (US 5751303), and further in view of Stoffel et al. (US 6412990).

Martin, as modified, discloses the claimed invention as discussed above except using the video display as a touchscreen input device to capture operator preferences or acquiring data about pattern or configuration.

Stoffel et al. discloses an printing apparatus having a video display as a touchscreen (*FIG. 15, element 42*) input device to capture/acquire operator/customer preferences to allow the operator/customer to custom printing images by simply touching the viewing screen (*column 8, lines 55-60*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Marin's video display (as modified) as a touchscreen as disclosed by Stoffel et al. The motivation for doing so would have been to allow an operator/customer to custom printing images by simply touching the viewing screen as taught by Stoffel et al. (*column 8, lines 55-60*).

8. Claims 4, 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Erickson et al. (US 5751303), and further in view of Goldstein (US 2002/0069078 A1).

Martin, as modified, discloses the claimed invention as discussed above but is silent about charging a customer for the roll or obtaining/attempting to obtain a fee from a franchisee.

Goldstein discloses a system for creating custom wallpaper including a program to charge and obtain fee from customers ordered printed wallpaper rolls (*FIG. 2, steps 208, 210, 212, 214*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Martin's apparatus to include means for charging and obtaining fee from a customer as disclosed by Goldstein et al. The motivation for doing so would have been to allow an operator/customer to purchase created custom wallpaper as taught by Goldstein (*paragraphs [0043]-[0046]*).

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Erickson et al. (US 5751303), and further in view of Rottman (US 5526028).

Martin, as modified, discloses the claimed invention as discussed above except drying the web after it is printed on but before it is dispensed by the printer.

Rottman discloses a printing apparatus including a printhead assembly (*FIG. 1, element 16*) for forming images on a printing medium (*FIG. 1, element 17*) and a dryer (*FIG. 1, element 26*) for drying the printed images on the printing medium before the printed medium is dispensed.

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Martin's printing apparatus to include a dryer for drying printed images before the printed medium is dispensed as disclosed by Rottman. The motivation for doing so would have been to ensure ink deposited on the printing medium to form images is dried and fixed on the printing medium as taught by Rottman (*FIG. 1*).

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAM S. NGUYEN whose telephone number is (571)272-2151. The examiner can normally be reached on 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEPHEN D. MEIER can be reached on (571)272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LAM S NGUYEN/
Primary Examiner, Art Unit 2853